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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,050	07/28/2003	Jacques Louis Poret	Rev 00-25	4070

7590

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,050

Applicant(s)

PORET, JACQUES LOUIS

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Receipt of Preliminary Amendment filed July 28, 2003 is acknowledged. Claims **21-40** are pending in this application. Claims 1-20 stand cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 dependent on a cancelled claim, therefore the intended limitation of this claim is indefinite and vague.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greff (WO 98/06695) in further view of Cohen et al (5,560,917).

Greff discloses a topical composition containing instant melatonin derivative, palmitoyl-methoxytryptamine for the treatment of the skin. See Figure (a). The dermopharmaceutical is utilized for hydrating, regenerating, and bleaching the skin. See abstract. The reference discloses the instant derivatives allow the compound to be easily incorporated into a cosmetic product and has a stronger affinity for the epidermis. Moreover they are not irritating to the skin, they are stable and effective. (Note pg. 2, last paragraph and pg. 3, first paragraph). Greff teaches the compound may be formulated in the amount of 0.0001-10% into an o/w or w/o emulsions, milks, lotions, sticks, crayons, etc. See page 5. The dermopharmaceutical may be used as an anti-wrinkle/anti-agent formulation, for moisturizing, and protecting cream against the effects of UV radiation. See page 5. Example 2 teaches a face cream containing 1.5% instant melatonin derivative, 2.4% Brij 721 (steareth-21), 2.6% Brij 72 (steareth-2), 8% Arlamol, 0.5% beeswax, 3% Abil (dimethicone copolyol surfactant), 3% propylene glycol, 0.25 carbopol, 0.25 triethanolamine, and water to balance. Talc and other mineral supports are taught in claim 5.

Greff does not teach the amount of pigments in the composition.

Cohen et al teach a water-in-oil emulsion cosmetic composition to protect the skin from the environment, improves complexion, etc. See abstract. The composition retards effects of aging caused by exposure of the skin to sunlight and natural aging by moisturizing. Further, the composition provides one single easy application of a composition that provides an attractive coloration to the skin while providing bioactive agents, moisturizing agents, and sunscreen. See column 2, lines 40-55. Cohen et al teach the use pigments such as titanium dioxide and zinc

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oxide in the amount of 0.1-20%. See column 4, lines 10-25 and Table 1. The concentration depends on the desired effect and blocking ability of the sunscreen. See column 5, lines 4-20. Cohen also teaches the use of pigments/colorants such as titanium dioxide, talc, red iron oxide, etc. in the amount of 0.5-20% depending on the color desired. Lastly, Cohen teaches the use of volatile silicone oils, cyclomethicone, as the carrier oil in the oil phase. See examples.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Greff and Cohen et al and utilize the instant amount of pigment. One would have been motivated to do so since Cohen et al teach the use of pigments such as titanium dioxide to not only provide sun screening benefits but to also impart color to the skin. Further, Cohen teaches this ability to provides several benefits in one easy application. Therefore, one would be motivated to utilize the instant amount of pigment to provide the sunscreen benefit and provide the easy application of make-up and benefiting agents in one composition.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greff (WO 98/06695) in further view of Cohen et al (5,560,917) in further view of JP 408283144 (abstract only).

As set forth above, Greff teaches the instant compound in a face cream, sunscreen, etc. Cohen et al teach the amount of pigment contained in a make-up composition.

The references do not teach the use of salicylic acid in the formulation.

JP teaches the use of salicylic acid on the amount of 0.01-2% with titanium oxide in a w/o or o/w emulsions to depigment the skin. The salicylic acid has the ability of inhibiting melanin synthesis. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the above references and incorporate salicylic acid in the formulation. One would be motivated to do so since JP teaches the use of salicylic acid to depigment the skin. Therefore, one would expect an additive effect if not a synergistic effect utilizing the combination of two depigmenting agents.

Claims 21-22, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al (5932608) in view of Greff (WO 98/06695) or vice-versa.

Nguyen et al disclose a topical composition containing a melatonin derivative (6-Hydroxymelatonin) for whitening and depigmenting the skin. The cosmetic or dermatological composition contains conventional additives known to those skilled in the art, such as emulsifiers, gelling agents, active agents, antioxidants, screening agents, dyes, etc. see column 4, lines 13-26. Exemplary oils utilized are plant oils, mineral oils, and silicone oils such as cyclomethicone. Exemplary hydrophilic active agents are glycerol, sorbitol, and allantoin. Exemplary UV screening agents are titanium oxide and zinc oxide. See column 4, lines 44-65. The dermocosmetic may be formulation into w/o or o/w emulsions in cream form wherein emulsifiers are utilized in the range of 0.1-15% and co-emulsifiers in the amount of 0.05-10%. Lastly, the composition may take the form of a protective cream for the face or body, treatment lotion, foundations, or tinted creams. For foundations and cream, the composition contains a pigment. See column 5, lines 1-5. The examples teach an oil in water emulsions wherein the composition contains 0.05% of 6-Hydroxymelatonin, 5% octyldodecanol, 11% sunflower oil, 5% cyclomethicone, 4% glycerol, 0.6% glyceryl stearate, 0.6% PEG-100 stearate, 1.2% PEG-20 stearate, and water to balance.

Nguyen et al do not teach instant melatonin derivative, palmitoyl-methoxytryptamine.

Greff discloses a topical composition containing instant melatonin derivative, palmitoyl-methoxytryptamine for the treatment of the skin. See Figure (a). The dermatopharmaceutical is utilized for hydrating, regenerating, and bleaching the skin. See abstract. The reference discloses the instant derivatives allow the compound to be easily incorporated into a cosmetic product and has a stronger affinity for the epidermis. Moreover they are not irritating to the skin, they are stable and effective. (Note pg. 2, last paragraph and pg. 3, first paragraph). Greff teaches the compound may be formulated in the amount of 0.0001-10% into an o/w or w/o emulsions, milks, lotions, sticks, crayons, etc. See page 5. The dermatopharmaceutical may be used as an anti-wrinkle/anti-agent formulation, for moisturizing, and protecting cream. See page 5. Example 2 teaches a face cream containing emulsifiers, propylene glycol, oil, and water in the instant amount. Greff teaches the use of Abil, a dimethicone copolyol surfactant. See example 2. Talc and other mineral supports are taught in claim 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Nguyen et al and Greff and utilize the instant palmitoyl-methoxytryptamine derivative in Nguyen's topical formulation. One would be motivated to do so since Greff teaches the instant compound has certain advantages such as stronger affinity for the epidermis, stability, and effectiveness. Further motivation to do so being that a homogenous product is yielded since Greff teaches the ability of the instant compound to easily incorporate into a cosmetic carrier.

Conversely, it would have been obvious to look to the teachings of Nguyen et al and incorporate pigments into Greff's face cream formulation. One would have been motivated to do

so if one desired to formulate a protective foundation having sun screening ability or tinted cream for the face. Therefore, the use of pigments in a cosmetic formulation is prima facie obvious since the incorporation of pigments depends on the desired aesthetic look and intended use of the formulation.

Claims 23, 27-38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al (5932608) in view of Greff (WO 98/06695) or vice-versa, in further view of Mauser et al (5,571,503).

As set forth above, Nguyen et al teach a tinted cream containing a melatonin derivative. Greff teaches the instant compound in a face cream, sunscreen, etc.

The references do not teach the concentration of the pigment, i.e. titanium dioxide.

Mauser et al teach anti-pollution cosmetic composition providing protection against environmental factors. Mauser teaches the use of a pigment to provide an aesthetically desirable appearance to the composition. Titanium dioxide is the preferred pigment in the amount of 0.01-1% and also provides protection against the sun. Depending on variable such as the skin tone of the consumer and the desired cosmetic effect, the titanium dioxide can be substituted. See column 13, lines 35-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the above references and utilize the instant amount of pigment. One would have been motivated to do so since Mauser et al teaches the conventional amount of a pigment in a cosmetic composition is within instant range Mauser also teaches the amount and type of pigment depends on the intended use of the composition and desired cosmetic look. Therefore, the manipulation of concentrations of components in the prior art is

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deemed prima facie obvious to a skilled artisan during routine experimentation. Furthermore, Nguyen also teaches the use of titanium dioxide as a UV filter and therefore one would be motivated to utilize the instant amount of the pigment to provide sun-screening benefits.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al (5932608) in view of Greff (WO 98/06695) or vice-versa, in further view of Mauser et al (5,571,503), in further view of JP 408283144 (abstract only).

As set forth above, Nguyen et al teach a tinted cream containing a melatonin derivative. Nguyen contemplates the use of other bioactives in the composition. Greff teaches the instant compound in a face cream, sunscreen, etc. Mauser et al teach the amount of pigment contained in the composition.

The references do not teach the use of salicylic acid in the formulation.

JP teaches the use of salicylic acid on the amount of 0.01-2% with titanium oxide in a w/o or o/w emulsions to depigment the skin. The salicylic acid has the ability of inhibiting melanin synthesis. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the above references and incorporate salicylic acid in the formulation. One would be motivated to do so since JP teaches the use of salicylic acid to depigment the skin. Therefore, one would expect an additive effect if not a synergistic effect utilizing the combination of two depigmenting agents.

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
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